

## REMARKS

Claims 1 and 9-20 have been amended.

Claim 21 has been added. No new matter has been added.

Claims 1-7 and 9-21 are pending.

5

The above amendments were made to further clarify that which is being claimed.

Prior to entry of the above amendments, in a Final Office Action mailed October 12, 2005, Claims 1-3, 7, 9-12 and 16-20 were rejected under 35 U.S.C 103(a) as being

10 unpatentable over:

U.S. Patent No. 6,269,382 issued to Cabrera et al. (*Cabrera*)

in view of :

U.S. Patent No. 6,704,118 issued to Hull et al. (*Hull*)

in further view of:

15 U.S. Patent No. 6,624,843 issued to Lennon (*Lennon*).

Prior to entry of the above amendments, in a Final Office Action mailed October 12, 2005, Claims 4-6 and 13-15 were rejected under 35 U.S.C 103(a) as being unpatentable over:

20 U.S. Patent No. 6,269,382 issued to Cabrera et al. (*Cabrera*)

in view of:

U.S. Patent No. 6,704,118 issued to Hull et al. (*Hull*)

in further view of:

U.S. Patent No. 6,624,843 issued to Lennon (*Lennon*).

25 and in further view of:

U.S. Patent No. 5,440,401 issued to Parulski et al. (*Parulski*).

These earlier rejections are addressed below and the pending claims distinguished there over.

*Cabrera* discloses computer systems and methods for migrating data from local  
5 storage to remote storage. *Cabrera* teaches techniques by which a pre-migration of data  
may occur prior to a planned migration time. Thus, when the time does arrive for the  
planned migration, the migration has already occurred. This may prove more efficient,  
however, it is noted that a copy of the pre-migrated data is stored in both the local data  
storage device and in the remote data storage device until the planned migration time, at  
10 which point the local copy can be deleted.

*Hull* discloses that a workstation can be connected to a network and configured  
to collect and store documents that are copied by a networked copier, printed by a  
networked printer, or faxed by a networked facsimile machine.  
15

*Lennon* discloses an image capturing system that produces a composite image  
using a video or still digital camera, a computer and display. The resulting composite  
image/video depicts a retail shopper as they might appear with (e.g., wearing) a retail  
product. *Lennon* teaches that the composite image may also be stored on an optical disc  
20 for the shopper to take home with them upon leaving the retail establishment.

*Parulski* discloses database techniques for storing digitized image data. Here  
two systems are used. The first system includes a 35mm filmstrip digitizing scanner that  
is connected to a workstation. The database techniques are performed within the  
25 workstation and as a result an optical disc is produced. The optical disc is then  
physically moved to the second system, which includes a playback device connected to a

television and thermal printer. The playback device allows for selective display or printing of either low or high resolution digitized image data.

Claim 1 recites:

5

1. A method for use with a unitary device, the method comprising:

10

with a unitary device comprising therein logic, a user interface, a scanning mechanism, a communication interface, and a removable data storage mechanism, wherein said logic is operatively coupled to said user interface to receive an inputted recipient electronic mail address, to said scanning mechanism to receive at least scanned object data obtained by optically scanning an object, to said communication interface to send an electronic mail message that includes at least a portion of said scanned object data to a remote device associated with said recipient electronic mail address, and to said removable data storage mechanism to access therethrough a removable data storage media when present:

15

20

receiving a removable data storage media in said removable data storage mechanism;

selectively operatively coupling said removable data storage media to said logic; and

25

storing at least an archival copy of at least said electronic mail message data sent via the communication interface on said removable data storage media.

30

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

35

Furthermore, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

5           *Cabrera, Hull, Lennon, and/or Parulski*, alone and/or in combination, fail to disclose or otherwise even reasonably suggest “a unitary device comprising therein logic, a user interface, a scanning mechanism, a communication interface, and a removable data storage mechanism”, as recited in Claim 1.

Consequently, *Cabrera, Hull, Lennon, and/or Parulski*, alone and/or in  
10 combination fail to further disclose or otherwise suggest that such logic is operatively coupled to said user interface to receive an inputted recipient electronic mail address, and/or the acts recited in Claim1 of:

                  receiving a removable data storage media in  
                  said removable data storage mechanism;  
15               selectively operatively coupling said  
                  removable data storage media to said logic; and  
                  storing at least an archival copy of at least  
                  said electronic mail message data sent via the  
                  communication interface on said removable data  
20               storage media

To combine *Cabrera, Hull, Lennon, and/or Parulski* to produce the method recited in Claim 1 and in particular a unitary device, appears to require the impermissible use of hindsight using Applicant's claim as a blueprint.

25           There is simply no stated motivation in any of the cited references to combine the four unique and disparate multiple-device networked systems into a unitary device as claimed. Indeed, if anything, these references solve problems that exist partially, if not solely, because of the disparate devices in their respective networked configurations. Hence, rather than provide for reasonable motivation to combine their ideas as suggested

in the earlier Final Office Action, the references actually teach away from the method for use with such a unitary device as recited in pending Claim 1.

For at least these reasons and others, pending Claim 1 is clearly patentable over *Cabrera, Hull, Lennon, and/or Parulski*, alone or in combination, as are pending  
5 dependent Claims 2- 7, 9-10 and 21, each of which adds further novel limitations to that of Claim 1.

Claim 11 recites:

10                    11.    A unitary device comprising:  
                      a data storage mechanism configurable to access a  
removable data storage media,  
                      an optical scanning mechanism configurable to  
15                    optically scan at least one object and produce corresponding  
scanned object data,  
                      a communication interface configurable to  
operatively connect to at least one other device over at least  
one network,  
                      a user interface configurable to receive user inputs,  
20                    and  
                      logic operatively coupled to said data storage  
mechanism, said optical scanning mechanism, said  
communication interface, and said user interface, wherein  
25                    said logic is configured to combine recipient electronic mail  
address data received through said user interface with at  
least a portion of said scanned object data to form electronic  
mail message data that is then output by said communication  
interface, and wherein said logic is further configured to  
30                    selectively archive at least a portion of said electronic mail  
message data by providing said portion of said electronic  
mail message to said data storage mechanism for storage on  
said removable data storage device.

For at least some of the same reasons as stated above with regard to Claim 1,  
35    *Cabrera, Hull, Lennon, and/or Parulski*, alone and/or in combination, fail to disclose or  
otherwise even reasonably suggest the unitary device as recited in Claim 11.

For example, the cited references fail to disclose or reasonably suggest a unitary device having:

5           logic operatively coupled to said data storage  
mechanism, said optical scanning mechanism, said  
communication interface, and said user interface, wherein  
said logic is configured to combine recipient electronic mail  
address data received through said user interface with at  
10       least a portion of said scanned object data to form electronic  
mail message data that is then output by said communication  
interface, and wherein said logic is further configured to  
selectively archive at least a portion of said electronic mail  
message data by providing said portion of said electronic  
15       mail message to said data storage mechanism for storage on  
said removable data storage device.

For at least these reasons and others, pending Claim 11 is clearly patentable over  
*Cabrera, Hull, Lennon, and/or Parulski*, alone or in combination, as are pending  
dependent Claims 12-20, each of which adds further novel limitations to that of Claim  
20   1.

The pending claims are clearly allowable over the cited art and in a ready  
condition for prompt allowance.

25

Dated: 12/12/2005

Respectfully Submitted,

/Thomas A. Jolly/  
Thomas A. Jolly  
Reg. No. 39,241  
(541) 715-7331